



UNITED STATES PATENT OFFICE

AMENDMENT TO UTILITY PATENT APPLICATION

Appl. No.: 10/673,599

: Atty Dkt No.: 2654.02 Div

Filing Date: 09/29/2003

: Examiner : André J. Allen

Applicant: Alan Alexander Burns

: Art Unit: 2855

Date: October 7, 2005

: Paper No.:

Title: **MAGNETIC LIQUID CRYSTAL DISPLAY**

RESPONSE TO OFFICE ACTION

Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Commissioner:

Responding to the communication from Examiner André J. Allen mailed 07 September 2005, the Applicant notes and greatly appreciates the indication that dependant Claims 12 - 17¹ would be allowable claims if rewritten as independent claims incorporating the limitations of base claim 1 and intervening dependant claim 7.

PRELIMINARY REMARKS:

Rejections pursuant 35 U.S.C. §102:

Applicant notes that Examiner Allen has misapplied 35 USC § 102 citing U.S. Patent No. 4,581,579 *Nagatsuma et al*, entitled '*OPTICAL MAGNETIC FIELD MEASURING APPARATUS HAVING IMPROVED TEMPERATURE CHARACTERISTICS*' as anticipating subject matter, rejecting Applicant's original claims 1-8.

For anticipation under 35 U.S.C. 102, each and every limitation expressed in a claim must be found, either expressly or inherently, in a single prior art reference *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998) [See also *IN RE CRISH*, 04-1075 Disc. Section (Fed. Cir. Dec. 2004) *Glaxo Inc. v. Novopharm Ltd.*, C.A.Fed. (N.C.) 1995, 52 F.3d 1043, 34 U.S.P.Q.2d 1565, rehearing denied, in banc suggestion declined, certiorari denied 116 S.Ct. 516.

Anticipation of invention occurs only when some single prior article, patent, or publication contains within its four corners every element of a claim in question; patentability is not anticipated when its elements are distributed among several prior publications or devices. *Paeco, Inc. v. Applied Moldings, Inc.*, C.A.3 (Pa.) 1977, 562 F.2d 870, 194 U.S.P.Q. 353.

¹ The Examiner indicates dependant Claim 11 is rejected in the Office Action Summary

Even though an Examiner is entitled to give claims presented their broadest reasonable interpretation [*IN RE CRISH*, *ibid*], an element/step positively recited in the claim(s) cannot be disregarded.

Applicant's claim 1 recites a method for *displaying a magnetic field direction* with a magneto-optical cell having the steps of providing magnetic field having a particular direction and measuring light transmission properties of a magneto-optic cell located in the field in relation to *changes in the direction of* provided magnetic field.

Nagatsuma et al, on the other hand, describes a magneto-optic cell that measures magnitude of a magnetic field, i.e., the scalar quantities of magnetic field strength or intensity, rather than *displaying direction* of sensed magnetic fields. (See also U.S. Patent No. 4,896,103, *Shimanuki et al*)². In fact, contrary to the Examiner's assertion, nowhere in *Nagatsuma et al* or in *Shimanuki et al* is there any teaching or mention of *changes in the direction* of the provided magnetic field, nor any teachings or mention that the magnetic anisotropy properties of the involved magneto-optic compositions could be utilized to sense/measure, much less *display, magnetic field direction*.

Nor do *Nagatsuma et al* or *Shimanuki et al* describe, teach or suggest a magneto-optic cell having a light reflecting cell wall (Applicant's claim 4).

Notwithstanding, while neither *Nagatsuma et al* nor *Shimanuki et al* can be properly cited as anticipating the limitations expressed in Applicant's original claims 1-5 & 7 under 35 U.S.C. § 102 because of differences, such differences could properly be taken into account to determine patentability of claimed subject matter under the obviousness criteria expressed at 35 U.S.C. § 103 [See *Titanium Metals Corp. of America v. Banner*, (Fed. Cir. 1985) 778 F.2d 775, 780, 227 U.S.P.Q. 773.]

Rejections pursuant 35 U.S.C. §103:

The Applicant notes that in articulating rejections of claims under 35 U.S.C. § 103, Examiner Allen did not make a key preliminary legal inquiry **before** including a reference per the "content" inquiry specified in *Graham v. John Deere Co.* 383 U.S.1, 17-18 [86 S.Ct. 684, 693-94, 15 L.Ed.2d 545, 556-57], 148 USPQ 459, 467 (1966)³. In particular, **it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102** before it can be cited as a reference for ascertaining obviousness under 35 U.S.C. § 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987 (emphasis added)).

² *Shimanuki et al* describes current measuring magnetic field sensors of the type improved by *Nagatsuma et al*.

³ Cited by Examiner Allen in the Office Action.

In addition to *Nagatsuma et al* (a proper 35 U.S.C. § 102 prior art reference) Examiner Allen cites U.S. Patent Application Publication No. US 2003/0090012, *Allen et al* filed September 27, 2001 and published on May 15, 2003. The *Allen* Patent Application Publication is **not a prior art reference under 35 U.S.C. § 102** to Applicant's present divisional application.

5 In particular, Applicant's present application filed September 29, 2003, stems from an election/restriction requirement made by the Patent Office pursuant 35 U.S.C. §121 in his then co-pending U.S. Patent Application Serial No. 09/927,763 filed August 10, 2001, that issued November 18, 2003 as U.S. Patent No. 6,647,771 B2 entitled 'EXTERNAL PRESSURE DISPLAY FOR VEHICLE TIRES.'

10 35 U.S.C. § 121 provides a non-elected invention that is made the subject of a divisional application in compliance with the requirements of 35 U.S.C. §120 is entitled to the benefit of the filing date of the original application. 35 U.S.C. §120 only requires that the subsequent application: (i) be filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application; and (ii) contain or is amended to contain a specific reference to the earlier filed application.

15 In his prior co-pending SN09/927,763 application, Applicant responded to Examiner Allen's restriction demand, stating:

20 "Responding to the restriction requirement requested by Examiner Allen, the Applicant elects the invention classified in Category I for examination, namely Claim Nos. 1 – 10 and 21 - 27 respectively drawn to 'A method for' and 'An apparatus' for displaying magnitude."

The claims of Applicant's current application are the Category II group characterized by Examiner Allen in the prior co-pending SN09/927,763 application as being "*Claims 11 and 12-20 drawn to a method for displaying magnitude direction, classified in class 359, subclass 489*".

In particular:

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1. The subject matter of original SN09/927,763 independent claim 12 is presented in current independent claim 1 and dependant claims 1-7;
 2. The subject matter of original SN09/927,763 dependent claim 13-12 is presented in current dependant claim 8;
 3. The subject matter of original SN09/927,763 dependent claim 14-12 is presented in current
 - 30 4. The subject matter of original SN09/927,763 dependent claim 15-12 is presented in current dependant claim 10;

5. The subject matter of original SN09/927,763 dependent claim 16-12 is presented in current dependant claim 11;
6. The subject matter of original dependent claim 17-12 was presented in canceled claim 12 currently rewritten as new independent claim 18;
7. The subject matter of original SN09/927,763 dependent claim 18-12 was presented in canceled claim 13 currently rewritten as new independent claim 19;
8. The subject matter of original SN09/927,763 dependent claim 19-12 is presented in current dependant claims 14 & 16;
9. The subject matter of original SN09/927,763 dependent claim 20-19-12 is presented in current dependant claims 15 & 17.

35 U.S.C. § 112, 2nd ¶ requires a patent application specification to conclude with claims particularly pointing out and distinctly claiming the subject matter that is regarded as the applicant's invention. Accordingly, it is clear that Applicant's current application is a division application drawn to the subject a of one of the other inventions subject to the restriction/election requirements of the Commissioner in Applicant's prior co-pending SN09/927,763 application meeting the subject matter requirements of 35 U.S.C. §121.

Further, the original CROSS REFERENCES TO RELATED APPLICATIONS section of Applicant's current application unambiguously states, "This Application is a division of Ser. No. 09/927,736 filed August 10, 2001."⁴, and was filed on September 9, 2003 before the patenting of prior co-pending SN09/927,763 application on **November 18, 2003** satisfying the requirements of 35 U.S.C. §120. Accordingly under 35 U.S.C. § 121 Applicant's current application has the benefit of an **August 10, 2001** filing date.

Under 35 USC § 102(b) for an application of another, published under section 122(b) to be *prior art* to a current patent application, **it must have been published** more than 1 year prior to the applicable filing date of the patent application.

Under 35 U.S.C. § 102(e) for a patent application of another published under section 122(b) to be consider *prior art*, to Applicant's current patent application, (1) **it must have been published** before the invention made by the Applicant, or (2) **it must have been filed** in the U.S. before the invention made by the Applicant and **patented**.

⁴ The CROSS-REFERENCES TO RELATED APPLICATIONS section is currently amended to more accurately recite all related applications and consequent patents.